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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,811	01/16/2004	Raynold M. Kahn	PD-200290	6578

20991 7590 02/27/2009

THE DIRECTV GROUP, INC.
PATENT DOCKET ADMINISTRATION
CA / LA1 / A109
2230 E. IMPERIAL HIGHWAY
EL SEGUNDO, CA 90245

EXAMINER	
PARTHASARATHY, PRAMILA	
ART UNIT	PAPER NUMBER
2436	

MAIL DATE	DELIVERY MODE
02/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/758,811	KAHN ET AL.	
	Examiner	Art Unit	
	PRAMILA PARTHASARATHY	2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/15/08;7/18/08;8/29/08;11/18/08;12/05/08;1/23/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 7/15/08; 7/18/08; 8/29/08; 11/18/08; 12/05/08 and 1/23/08 are considered by the examiner and initialed/dated copies have been attached to this office action.

Response to Arguments

Applicant's arguments filed 09/04/2008 have been fully considered but they are not persuasive. Examiner maintains obviousness-type double patenting rejection and additionally, provides details with partial comparison of claims from each of the applications/patents that were cited in previous office action. Examiner respectfully requests the Applicant to file Terminal Disclaimer to overcome the obviousness-type double patenting.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1 – 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 34 of copending Application No. 09/620,772 (now Patent 7,457,414). Although the conflicting claims are not identical, they are

not patentably distinct from each other because the instant case, all elements of claims 1 – 21 correspond to the claims of 1 – 34 of the copending application claims, except in the instant claims element “generating a copy protection key at the client receiver using the family pairing key and decrypting the transferred program material at the client receiver using the copy protection key” is referred in the copending application claims as “wherein the access control information further comprises ... generating the second encryption key at least in part from the metadata" and "decrypting the re-encrypted material using the second encrypting key”. It would have been obvious to one having ordinary skill in the art to recognize that “decrypting the transferred program material using the copy protection key” is equivalent to “decrypting the re-encrypted the re-encrypted material using the second encrypting key (generated by using the program material)”.

A partial correspondence between the instant claims and the copending claims are as follows:

10/758,811	09/620,772 (Patent 7,457,414)
Transmitting a family paring key from the broadcast system to both host receiver and the client receiver; decrypting program material received by the host receiver from the broadcast system; generating a copy protection key at the host receiver using the family pairing key; encrypting the decrypted program materials at the host receiver using the copy protection key; transferring the encrypted materials from the host receiver to the client receiver; generating the copy protection key at the client receiver using the family paring key; and decrypting the transferred program materials at	accepting a data stream including data packets with program material encrypted according to a first encryption key … in the receiver; decrypting the received access information in a conditional access module … to produce the first encryption key; decrypting the program material in the receiver using the first encryption key; re-encrypting the program material according to a second encryption key … providing the re-encrypted program material and the fourth encryption key ...conditional access module; …generating the second encryption key at least in part from the metadata; decrypting the re-encrypted material using the

the client receiver using the copy protection key;	second encryption key;

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitations of the instant application. Claims of the instant application therefore is not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting *(In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993).*

2. Claims 1 – 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4 – 6, 8 – 23, 26 – 28, 30 – 55 of copending Application No. 09/620,833. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 21 correspond to the claims of the copending application claims, except in the instant claims element “decrypting the transferred program material at the client receiver using the copy protection key” is referred in the copending application claims as “..programming material encrypted according to a first encryption key; decrypting the program material; re-encrypting the decrypted program material according to a receiver-unique second encryption key and decrypting the received re-encrypted program material". It would have been obvious to one having ordinary skill in the art to recognize that “decrypting the transferred program material using the copy protection key” is equivalent to “decrypting the re-encrypted using the receiver-unique second encrypting key (generated by using the access control information)”.

A partial correspondence between the instant claims and the copending claims are as follows:

10/758,811	09/620,833
Transmitting a family paring key from the broadcast system to both host receiver and the client receiver; decrypting program material received by the host	receiving a data stream comprising program material encrypted according to a first encryption key; decrypting the encrypted program material;

receiver from the broadcast system; generating a copy protection key at the host receiver using the family pairing key; encrypting the decrypted program materials at the host receiver using the copy protection key; transferring the encrypted materials from the host receiver to the client receiver; generating the copy protection key at the client receiver using the family paring key; and decrypting the transferred program materials at the client receiver using the copy protection key;	re-encrypting the decrypted program material according to a receiver-unique second encryption key; encrypting the receiver-unique second encryption key according to a receiver-unique third encryption key; storing the re-encrypted program material retrieving the stored re-encrypted program material; decrypting the retrieved re-encrypted material;

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitations of the instant application. Claims of the instant application therefore is not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting *(In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993).*

3. Claims 1 – 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 31 of copending Application No. 10/758,865. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 21 correspond to the claims of the copending application claims, except in the instant claims element “generating a copy protection key at the client receiver using the family pairing key and decrypting the transferred program material at the client receiver using the copy protection key” is referred in the copending application claims as “encrypting copy protection key at the host receiver using a host-client paring key generated by the service provider and shared between a host receiver

and a client receiver" and "decrypting the transferred copy protection key at the client receiver using the host-client paring key". It would have been obvious to one having ordinary skill in the art to recognize that "decrypting the transferred program material using the copy protection key" is equivalent to "decrypting the transferred program materials at the client receiver using the decrypted copy protection key".

A partial correspondence between the instant claims and the copending claims are as follows:

10/758,811	10/758,865
transmitting a family paring key from the broadcast system to both host receiver and the client receiver; decrypting program material received by the host receiver from the broadcast system; generating a copy protection key at the host receiver using the family pairing key; encrypting the decrypted program materials at the host receiver using the copy protection key; transferring the encrypted materials from the host receiver to the client receiver; generating the copy protection key at the client receiver using the family paring key; and decrypting the transferred program materials at the client receiver using the copy protection key;	receiving encrypted program materials, generated by a service provider… includes at least one host receiver and at least one client receiver; decrypting the received program material at the host receiver; re-encrypting the decrypted program materials in the host receiver using a copy protection key; encrypting the copy protection key at the host receiver using a host-client pairing key …for a particular combination of the host and client receivers; transferring the re-encrypted program materials and the encrypted copy protection key from the host receiver to the client receiver; .. decrypting the transferred program materials at the client receiver using the decrypted copy protection key;

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitations of the instant application. Claims of the instant application therefore is not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting *(In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993).*

4. Claims 1 – 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 22 of copending Application No. 10/758,818. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 21 correspond to the claims of the copending application claims, except in the instant claims element "generating a copy protection key at the client receiver using the family pairing key and decrypting the transferred program material at the client receiver using the copy protection key" is referred in the copending application claims as "receiving an encrypted media encryption key at the host receiver" and "decrypting the encrypted media encryption key at the client receiver using the pairing key". It would have been obvious to one having ordinary skill in the art to recognize that "decrypting the transferred program material using the copy protection key" is equivalent to "decrypting the encrypted program materials … using the decrypted media encryption key".

A partial correspondence between the instant claims and the copending claims are as follows:

10/758,811	10/758,818
transmitting a family paring key from the broadcast system to both host receiver and the client receiver; decrypting program material received by the host receiver from the broadcast system; generating a copy protection key at the host receiver using the family pairing key;	receiving an encrypted media encryption key at the host receiver; decrypting the encrypted media encryption key at the host receiver; re-encrypting the decrypted media encryption key at the host receiver using a pairing key; transferring the re -encrypted media encryption

encrypting the decrypted program materials at the host receiver using the copy protection key; transferring the encrypted materials from the host receiver to the client receiver; generating the copy protection key at the client receiver using the family paring key; and decrypting the transferred program materials at the client receiver using the copy protection key;	key from the host receiver to the client receiver… decrypting the re-encrypted media encryption key at the client receiver using the pairing key; receiving the encrypted program materials form the broadcast system at the host receiver; decrypting the encrypted program materials at the client receiver using the decrypted media encryption key;

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitations of the instant application. Claims of the instant application therefore is not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting *(In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993).*

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRAMILA PARTHASARATHY whose telephone number is (571)272-3866. The examiner can normally be reached on 8:00a.m. to 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pramila Parthasarathy/
Primary Examiner, Art Unit 2436
January 29, 2009